

REMARKS

Initially, Applicants would like to express appreciation to the Examiner for the detailed Official Action provided and for the acknowledgment of Applicants' Information Disclosure Statements by return of the forms PTO-1449.

Upon entry of the present amendment, the specification and claims 1, 2, 4, 7, 10 and 15 will have been amended. Claims 1-19 remain pending in the present application. Applicants respectfully request reconsideration of the outstanding objections and rejections and allowance of all the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

The Examiner has noted that the oath/declaration is defective, finding that the second partially-executed Declaration (executed by inventors HWANG and CHUNG) is defective because it fails to properly identify the specification by the correct title. Applicants respectfully traverse the Examiner's determination, and note that this declaration indeed properly identifies the application. Specifically, Applicants direct the Examiner's attention to MPEP 602(VI), which notes the following:

The following combinations of information supplied in an oath or declaration filed after the filing date of the application are acceptable as minimums for identifying a specification and compliance with any one of the items below will be accepted as complying with the identification requirement of 37 CFR 1.63:

(A) application number (consisting of the series code and the serial number, e.g., 08/123,456);

(B) serial number and filing date;

(C) attorney docket number which was on the specification as filed;

(D) title of the invention which was on the specification as filed and reference to an attached specification which is both attached to the oath or declaration at the time of execution and submitted with the oath or declaration; or

(E) title of the invention which was on the specification as filed and accompanied by a cover letter accurately identifying the application for which it was intended by either the application number (consisting of the series code and the serial number, e.g., 08/123,456), or serial number and filing date. Absent any statement(s) to the contrary, it will be presumed that the application filed in the USPTO is the application which the inventor(s) executed by signing the oath or declaration.

Applicants note that since both requirements (C) and (E) above have been satisfied by this second declaration (which was submitted with a Cover Letter and identifies Attorney Docket No. P23589), it is respectfully submitted that both executed declarations are in compliance with 37 CFR § 1.67(a), and thus respectfully request that the Examiner withdraw his finding.

The Examiner has objected to the drawings, noting that reference character “11” was not described in the specification, and requiring that Figs. 1-3 be relabeled from “background art” to “prior art.” In compliance with the Examiner’s requirement, reference character 11 has been deleted from the figures, and Figs. 1-3 have been relabeled from “background art” to “prior art.” It is thus respectfully requested that the Examiner withdraw the objection to the drawings.

The Examiner has objected to the specification, noting Applicants' incorporation by reference of the Korean patent application. In response, Applicants have deleted the phrase from the specification that refers to this incorporation. It is thus respectfully requested that the Examiner withdraw the objection to the specification.

The Examiner has rejected claims 1-4, 7-11 and 14-17 under 35 U.S.C. § 103(a) as being unpatentable over Applicants' Admitted Prior Art in view of Japanese patent publication No. JP 10-15661 (the abstract thereof upon which the Examiner relies), finding that Applicants' Admission teaches all of the limitations of the above claims, but fails to disclose, *inter alia*, the inclusion of either the base blocking or groove blocking protrusion. However, the Examiner has determined that JP 10-15661, directed to a method of joining pipes, teaches such limitations, and concludes that it would have been obvious to incorporate such limitations into the Admission.

Applicants respectfully traverse the Examiner's rejection. Specifically, Applicants note that JP 10-15661, as noted above, is directed to a method of joining pipes, and discloses a coupling member that has "a number of sealing projections (5)" which "are bent to form a number of pleats by interference with the inserted pipe." As such, JP 10-15661 does not have protrusions that *non-deformingly* contact an adaptor (as claimed in independent claims 1, 7 and 15 and in dependent claims 4 and 10). Rather, the projections of JP 10-15661 deform when a pipe is inserted into the coupling member. As such, if the deformable

projections of JP 10-15661 were used in the reciprocating device, it would result in a loss of precision, thereby rendering the claimed device ineffective for transferring heat. Further, Applicants submit that the art relating to the present claimed invention, directed to a heat transfer member for a reciprocating device, and the art related to the applied JP 10-15661 reference, directed to a method of joining pipes, are non-analogous, *In re Ellis*, 476 F.2d 1370, 1372, 177 USPQ 526, 527 (CCPA 1973), and thus not properly combinable.

Moreover, Applicants respectfully submit that the Examiner has not set forth a proper motivation as required by 35 U.S.C. § 103 to combine the teachings of the references in the manner asserted by the Examiner. It is clear that in the rejection under §103, the Examiner has, based upon Applicants' own disclosure, picked various individual features of the applied references and has combined them in the manner taught only by Applicants' disclosure. This hindsight reconstruction of the prior art to arrive at Applicants' claimed invention is inappropriate under 35 U.S.C. § 103.

Thus, while JP 10-15661 is directed to a method of joining pipes, the disclosed method is not in any way directed to a heat transfer member for a reciprocating device, and thus lacks the necessary teaching with respect to specific recited features of Applicants' claims. This document also fails to provide the recited subject matter noted above as deficient in the Admitted Prior Art and fails to provide the necessary motivation for modifying the Admitted Prior Art in any proper manner that would render unpatentable the

invention as claimed in independent claims 1, 7 and 15.

With respect to the Examiner's rejection of dependent claims 2-6, 8-14 and 16-19 under 35 U.S.C. §103(a), as these claims are dependent from one of independent claims 1, 7 and 15, which are allowable for at least the reasons discussed *supra*, these dependent claims are also allowable. Further, all dependent claims set forth a combination of elements neither taught nor suggested by any of the references of record. Accordingly, the Examiner is respectfully requested to withdraw the rejections under 35 U.S.C. §103(a).

Thus, Applicants respectfully submit that each and every pending claim of the present application meets the requirements for patentability under 35 U.S.C. § 103, and respectfully request the Examiner to indicate the allowance of each and every pending claim in the present application.

SUMMARY AND CONCLUSION

In view of the foregoing, it is submitted that the present amendment is in proper form and that none of the references either taken together or taken alone in any proper combination thereof, anticipates or renders obvious Applicants invention. In addition, the applied references of record have been discussed and distinguished, while significant features of the present invention have been pointed out. Accordingly, consideration of the present amendment, reconsideration of the outstanding Official Action and allowance of the present application and all of the claims therein are respectfully requested and are now believed to

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be appropriate.

Applicants note that this amendment is being made to advance prosecution of the application to allowance, and with respect to the subject matter argued as deficient in the prior art, should not be considered as surrendering equivalents of the territory between the claims prior to the present amendment and the amended claims. Further, no acquiescence as to the propriety of the Examiner's rejection is made by the present amendment. All other amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto. For example, claim 2 has been amended to address a clerical error therein.

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Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
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